UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,291	03/09/2001	Shimon Shmueli	4989-007	1208

27820 7590 01/07/2004

WITHROW & TERRANOVA, P.L.L.C.
P.O. BOX 1287
CARY, NC 27512

EXAMINER	
VU, KIEU D	

ART UNIT	PAPER NUMBER
2173	6

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/803,291	SHMUELI ET AL.	
	Examiner	Art Unit	
	Kieu D Vu	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-9, 11-15, 17, 21-25, 27-29, 33-37, and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrendoerfer et al ("Herrendoerfer", USP 6481621).

Regarding claims 1, 17, and 29, Herrendoerfer teaches a portable device which has a body (smart cart 130), a memory containing software for executing on a host computing device 118; an interface to facilitate interaction with the host computing device (col 1, lines 50-52); and the software adapted to automatically execute on the host computing device in association with a computing session and provide an interface frame associated with the portable device on a display of the host computing device (col 3, lines 4-11).

Regarding claims 5-6, 21-22, and 33-34, Herrendoerfer teaches the providing a link to a web site associated with the provider of the portable device on the interface frame (col 4, lines 55-57).

Regarding claims 7-8, 23-24, and 35-36, Herrendoerfer teaches the display the web content in the interface frame (col 5, lines 29-32).

Regarding claims 9, 25, and 37, Herrendoerfer teaches the markup language content (col 5, lines 21-24).

Regarding claims 11, 27, and 39, Herrendoerfer teaches the authentication routine (col 5, lines 34-36).

Regarding claims 12, 28, and 40, Herrendoerfer teaches the pushing web content (col 4, lines 55-58).

Regarding claims 13-14, Herrendoerfer teaches the emulating and adapting as a file system (col 4, lines 3-8).

Regarding claim 15, Herrendoerfer teaches the interface is adapted to directly interface a port (col 4, lines 64-65).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-4, 18-20, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrendoerfer and Suga et al ("Suga", USP 5497455).

Regarding claims 2, 18, and 30, Herrendoerfer does not teach the displaying icon on the interface frame. However, such feature is known in the art as taught by Suga. Suga teaches a portable computer which has a task selection menu which comprises

the displaying an icon, which when selected, the software will execute the corresponding function on the host computing device (col 2, lines 26-31). It would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Suga before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the icon display taught by Suga with the motivation being to help user to easily and quickly access functions.

Regarding claims 3-4, 19-20, and 31-32, Suga teaches the display a menu icons corresponding to a menu of function icons (Fig. 4).

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrendoerfer and Yee et al ("Yee", USP 5781723).

Regarding claim 16, Herrendoerfer does not teach a wireless interface. However, such feature is known in the art as taught by Yee. Yee teaches a system for self-identifying a portable information device which comprises the wireless interface (col 4, lines 1-3). It would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Yee before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the wireless interface taught by Yee with the motivation being to enhance the portability of the system.

6. Claims 10, 26, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrendoerfer and Zubeldia ("Zubeldia", USP 6397224).

Regarding claims 10, 26, and 38, Herrendoerfer does not teach the remove records to enhance privacy. However, such feature is known in the art as taught by Zubeldia. Zubeldia teaches a system for linking a plurality of data records which

comprises the record removal (col 1, lines 32-34). It would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Zubeldia before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the record removal taught by Zubeldia with the motivation being to increase the protection of user's privacy.

7. Applicant's arguments filed 11/03/03 have been fully considered but they are not persuasive.

In response to Applicant's argument that, in Herrendoerfer, "no teaching or suggestion that the information on the smart card 130 is determined to be software designed to execute on the host computing device", it is noted that it is not quite the case. According to the "Authoritative Dictionary of IEEE Standard Term" (Seventh Edition), "software" is "computer programs", "procedures", "associated documentation", and "data pertaining to the operation of a computer system". Therefore, in a reasonably interpretation, data read from the smart card 130 is a software. This software is designed to execute automatically on the host computing device 118 when the smart card 130 is inserted in the Card Station which is attached to the local computer 110 (col 2, lines 50-61).

In response to applicant's argument that there is no suggestion to combine Herrendoerfer and Suga references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since both inventions are in the same field of graphical user interface, it would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Suga before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the icon display taught by Suga with the motivation being to help user to easily and quickly access functions.

In response to applicant's argument that there is no suggestion to combine Herrendoerfer and Yee references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since both inventions are in the same field of graphical user interface, it would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Yee before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the wireless interface taught by Yee with the motivation being to enhance the portability of the system.

In response to applicant's argument that there is no suggestion to combine Herrendoerfer and Zubeldia references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since both inventions are teaching about personal identifiers (Herrendoerfer, col 5, lines 29-30) (Zubeldia, col 2, lines 1-9), it would have been obvious to one of ordinary skill in the art, having the teaching of Herrendoerfer and Zubeldia before him at the time the invention was made, to modify the portable device taught by Herrendoerfer to include the record removal taught by Zubeldia with the motivation being to increase the protection of user's privacy.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232). The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-872-9306

and / or:

(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

12/30/03

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100